UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to Applicant's amendment filed on 7/14/2008. Claims 1-19 are

amended. Claims 1-19 are presented for further examination.

2.   This is a final rejection.

Response to Arguments

I.   <u>The §101 rejection of claims 1-6</u>

Applicant amends independent claim 1 to now recite a user terminal which comprises a

web browser and a script engine. In Applicant's view, such an amendment was not even

necessary because "[a] script engine is known in the art as *residing in and controlling* hardware"

(italics added) and because the script engine performs operations on files that inherently involve

the use of hardware. The rejection of a claim under §101 for being software *per se* is that the

claims themselves only recite the software elements of a claim. The four statutory classes under

§101 are process, machine, manufacture, or composition of matter. The issue with software *per*

se claims is that software does not fall under any of these categories. Obviously, any software

"resides" in hardware but that does not save a software claim from statutory oblivion.

Applicant's amendment fails to place the claims in category as defined under §101.

A claim to an terminal or system does not inherently mean that the claim is directed to a

machine. Only if at least one of the claimed elements of the terminal is a *physical* part of a

device can the terminal as claimed constitute a device to be a machine under §101. Applicant's

claimed terminal recites only two elements, a web browser and a script engine. A web browser

is clearly not a physical part of a terminal. As discussed in the previous action and as admitted

by Applicant in the italicized portion of quote above, a script engine is merely software that

resides in hardware. Thus, the claimed terminal is directed merely towards software *per se* and

does not constitute a machine within the meaning of §101.

Since the issue is that claims are merely directed towards software, this rejection is easily

overcome if Applicant merely amends the claimed user terminal to include a clearly physical

element (consistent with Applicant's specification).

II.   The §102 rejections under Drummond and Junkerman

Applicant amends the claims with limitations directed towards a user terminal comprising

a web browser and a script engine. The script engine retrieves a file indicated by details passed

from the web browser and controls the computer by passing appropriate requests and responses

between the web browser and software agent. Applicant argues that Drummond does not teach

these new limitations. Specifically, Applicant argues that Drummond "does not address the

invocation by a browser of a specially designated file which is identified to a script engine, with

the script engine reading the file and taking actions as indicated by the file." Applicant's

arguments have been carefully considered but they are not persuasive because Drummond does

disclose the limitations as claimed.

Drummond discloses a web browser [Figure 3 «item 76»], a script engine [Figure 2 «item

80» | Figure 3 | 0062: disclosing that the JAVA environment executes JAVA scripts], and a

software agent [Figure 3 «item 92» : java program]. Drummond further discloses that browser

passes to the script engine a file to be invoked by a command sent from a user [Figure 3: input

received from a touch screen transmitted through the browser | column 8 «lines 1-7» | column 11

«line 61» to column 12 «line 13»: invoking an HTML file that includes an embedded JAVA

script where the script is passed to the java environment for execution]. Thus, the same benefits

extolled by Applicant in the response is found in Drummond. Drummond's use of JAVA scripts

allow modification of functionality by simply changing the JAVA script that is executed by the

java environment script engine [column 12 «lines 24-30»: scripts are loaded from a central

location providing selective software distribution to tailor the ATM to its environment | column

15 «lines 23-25»: script configures the browser]. Other limitations are addressed in the

following rejection.

Applicant's amendments do overcome the Junkerman reference and therefore the

rejection under §102 as being anticipated by Junkerman are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   At the outset, it is noted that claims 1-6 recite claim elements modified by "operative to"

or "configured to" clauses followed by claimed functionality. While amendment of these clauses

is not necessary, Applicant is reminded that use of these clauses does not mean that the elements

being modified must actually perform the functionality being claimed. These clauses merely

require that the claim elements *be capable* of performing the claimed functionality. For instance, consider the limitation claiming a client device configured to receive email. A reference that merely teaches a client device connected to a network or a client device containing an email software program would read on this limitation because the client device by simply being connected to a network or having an email program has been "configured" or is "operative" to receive email. The claim language does not require that the client device actually receive the email. See MPEP §2111.04 (stating that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed).

Similarly, Applicant's claims are written in this passive manner. Rather than affirmatively requiring the browser to receive user inputs or passing details identifying a file to a script engine, the browser only need be "operative to" perform these functions. Thus, the prior art only need teach a browser with touch screen and that is connected to a script engine would read on the claimed limitations. The prior art would not need to actually teach that the browser perform the functionality. Therefore, it would be beneficial to amend the claims to avoid these interpretation issues and affirmatively require the functionality to be performed.

4.   Claims 1-19 are rejected under 35 U.S.C. §102(e) as being anticipated by Drummond et al, U.S. Patent No. 6.970.846 ["Drummond"].

5.   As to claim 1, Drummond discloses a user terminal comprising:

a web browser operative to receive user inputs to a web page displayed under the control of the web browser [Figure 3 «items 30, 76»: touch screen] and respond to activation of a

specially designated command by passing to a script engine details identifying a file to be

invoked by the command that has been activated [column 4 «lines 34-40»: browser in connection

with the input device which enables user selection of hypertext link indicators | column 5 «lines

17-27» | column 9 «lines 46-58»: retrieving an HTML document containing a JAVA script

which is passed to the java environment for execution]; and

the script engine comprising a file executable by computer [Figure 2 «item 80»] and

causing the computer to mediate communication between the web browser and a software agent

[Figure 3 «items 12, 76, 16, 92»: the java environment causing the computer 12 to mediate

communication between the browser and the java program 92], the script engine being operative

to retrieve a file indicated by the details passed by the web browser to the script engine [column

4 «lines 34-36» | column 9 «lines 46-58»: retrieving an HTML document as indicated by the

browser] and to control the computer so as to pass appropriate requests and responses between

the web browser and the software agent as indicated by the retrieved file [column 9 «line 51» to

column 10 «line 3» | column 15 «lines 23-35»].

6.   As to claim 2, Drummond discloses the user terminal of claim 1 wherein the script engine

is configured to receive a request from the web browser for data or functionality available from

the software agent and transmit the request to the software agent [column 19 «lines 40-50» :

client inputting a request on the touch screen for a certain amount of funds from the back office

computer system].

7.   As to claim 3, Drummond discloses the user terminal of claim 2 wherein the script engine

is configured to receive a response from the software agent, and transmit the response to the web

browser in a format that can be recognized thereby [column 32 «lines 13-30» : taking the

information from the back office computer ("receive function command messages") and translate

the function command messages into TCP/IP messages for use by the browser].

8.   As to claim 4, Drummond discloses the user terminal of claim 1 wherein the script engine

is configured to translate the request from the web browser to a format that can be interpreted by

the software agent [column 19 «lines 46-50» | column 36 «lines 15-20 and 55-62» | column 38

«line 58» to column 39 «line 31» where : Drummond discloses submitting an HTTP request

from the browser which is converted into a conventional ATM request for the back office

computer systems to access the bank information].

9.   As to claim 5, Drummond discloses the user terminal of claim 4 wherein the script engine

is configured to translate the software agent response to a format that can be interpreted by the

web browser [column 32 «lines 22-26» | column 36 «lines 20-26»].

10.   As to claim 6, Drummond discloses user terminal of claim 1 wherein the format

interpretable by the web browser is HTML [column 19 «lines 40-50» | column 36 «lines 20-26»].

11.   Claim 7 is a directed to a method stored on a storage medium that implements the steps

for executing the functionality of the script engine as claimed in claims 1 and 2. Therefore, claim

7 is rejected for at least the same reasons set forth for claims 1 and 2.

12.   Claims 8-10 are directed to methods stored on a storage medium that implement the steps

for executing the functionality of the script engine as claimed in claims 3-5 respectively.

Therefore, claim 8-10 are rejected for at least the same reasons set forth for claims 3-5.

13.   Claim 11 is directed to a method that implements the steps for executing the functionality

of the script engine as claimed in claims 1, 2, and 4. Therefore claim 11 is rejected for at least the

same reasons set forth for claims 1, 2, and 4.

14.   Claims 12-15 are directed to methods that implement the steps for executing the

functionality of the script engine as claimed in claims 3-6 respectively. Therefore, claim 12-15

are rejected for at least the same reasons set forth for claims 3-6.

15.   As to claim 16, Drummond discloses a self-service terminal comprising:

        a web browser operative to receive user inputs to a web page displayed under the control

of the web browser [Figure 3 «items 30, 76»: touch screen] and respond to activation of a

specially designated command by passing to a script engine details identifying a file to be

invoked by the command that has been activated [column 4 «lines 34-40»: browser in connection

with the input device which enables user selection of hypertext link indicators | column 5 «lines

17-27» | column 9 «lines 46-58»: retrieving an HTML document containing a JAVA script

which is passed to the java environment for execution]; and

a script engine comprising a file executable by computer [Figure 2 «item 80»] and

causing the computer to mediate communication between the web browser and a software agent

based system [Figure 3 «items 12, 76, 16, 92»: the java environment causing the computer 12 to

mediate communication between the browser and the java program 92], the script engine being

operative to retrieve a file indicated by the details passed by the web browser to the script engine

[column 4 «lines 34-36» | column 9 «lines 46-58»: retrieving an HTML document as indicated

by the browser] and to control the computer so as to take action as indicated by the retrieved file

[column 9 «line 51» to column 10 «line 3» | column 15 «lines 23-35»].

16.   As to claim 17, Drummond discloses an automated teller machine (ATM) comprising:

a web browser operative to receive user inputs to a web page displayed under the control

of the web browser [Figure 3 «items 30, 76»: touch screen] and respond to activation of a

specially designated command by passing to a script engine details identifying a file to be

invoked by the command that has been activated [column 4 «lines 34-40»: browser in connection

with the input device which enables user selection of hypertext link indicators | column 5 «lines

17-27» | column 9 «lines 46-58»: retrieving an HTML document containing a JAVA script

which is passed to the java environment for execution];

display means for displaying a link in a web page in the web browser to allow an ATM

customer to request banking information by selecting the link [column 4 «lines 34-36» | column

7 «line 66» to column 8 «line 10»]; and

a script engine including (i) means for receiving details identifying a specially designated file corresponding to a request for banking information from the ATM customer when the ATM customer selects a link in the web page in the web browser invoking the file [column 4 «lines 34-40»: browser in connection with the input device which enables user selection of hypertext link indicators | column 5 «lines 17-27» | column 9 «lines 46-58»: retrieving an HTML document containing a JAVA script which is passed to the java environment for execution], (ii) means for retrieving the specially designated file [Figure 2 «item 86»], (iii) means for preparing a request to the software agent for banking information from the ATM customer as indicated by the specially designated file [column 13 «lines 11-22»], and (iv) means for transmitting the request to the software agent to allow the software agent to provide data associated with the banking information requested by the ATM customer [column 13 «lines 23-34»].

17.   Claim 18 is directed to the ATM that implements the steps for executing the functionality of the script engine of claim 5. Therefore claim 18 is rejected for at least the same reasons set forth for claim 5.

18.   Claim 19 is directed to an ATM that implements the steps for executing the functionality of the script engine of claim 6. Therefore claim 19 is rejected for at least the same reasons set forth for claim 6.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-

3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152